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REMARKS:

Claims 1-21 are pending in this application.

Claims 1-21 stand rejected.

Claim 1 has been amended to change "copolymer" in line 9 to have proper antecedent basis.

35 U.S.C. §112, first paragraph and second paragraph

Claims 1-21 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. The Examiner contends that the claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention. Specifically, the Examiner believes that "terpolymers" represent new subject matter in that it is contended that terpolymers are not described in the original specification.

Claims 1-21 also stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out, and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner contends that the term "terpolymers" in claim 1 has insufficient antecedent basis.

Applicant believes there is ample support in the Specification for a claim of terpolymers. In paragraph [0018] of the specification it cites "As used herein, the term "copolymer" includes polymers comprising two or more different monomeric units, e.g. polymers containing three different monomeric units, also known as terpolymers." Applicant's examples, as shown in Table 5 show the invention applicable to terpolymers. The terpolymer examples in Table 5 were specifically added to the parent application and claimed separately in the present application to claim the advantage seen in erosion performance and flexibility from this sub-set of copolymers.

The term "copolymer" on line 9 of claim 1 has been amended to read "terpolymer", for proper antecedent basis.

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Comments on the Response to Applicant's Arguments in the RCE

The Examiner has repeated the previous arguments regarding erosion rate, paint thickness and the mole percentage of triarylsilyl(meth)acryol groups. While Applicant still disagrees with these rejections, for the reasons on record, the main difference between the Gitlitz reference and the present invention is that Applicant claims a terpolymer, which is neither taught nor suggested in the Gitlitz reference.

Triarylsilyl(meth)acrylate terpolymers are not taught or suggested by the art in marine antifouling paint compositions.

35 U.S.C. §103(a)

Claims 1-21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Gitlitz et al, U.S. Patent Number 4,593,055. The Gitlitz reference fails to teach or suggest every claim limitation of Applicant's claims, and therefore fails to present a *prima facie* case of obviousness. Specifically, the '055 reference fails to teach or suggest that a terpolymer containing 9 to about 20 mole percent of triarylsilyl(meth)acryol groups can be used in a marine antifouling paint and have an erosion rate in seawater of from 2 to 15 microns per month.

The Gitlitz reference fails to teach or suggest a marine antifouling paint having terpolymers. It does cite "one or more copolymerizable ethylenically unsaturated monomers" (col 4, lines 8 and 9), however there is no teaching of any advantage to erosion rate or flexibility as surprising found by Applicant. Indeed, the Gitlitz reference teaches away from terpolymers by Exemplifying only copolymers having only two different monomers. Since the use of more than two monomers was not recognized as a result-effective variable by the Gitlitz reference, it cannot be optimized by routine experimentation (MPEP 2144.05). The use by Gitlitz of only two different monomer units in a polymer also teaches away from Applicant's claims.

Additionally, Applicant repeats the previously developed arguments regarding the failure of the Gitlitz reference showing

- 1) at what mol% level a triaryl(meth)acrylate should/could be effective;
- 2) any relationship between hydrolysis rate of a polymer and erosion rate of the polymer;
- 3) any relationship between the erosion rate of the paint composition of Gitlitz, and the erosion rate of the copolymer claimed by Applicant in amended claim 1;

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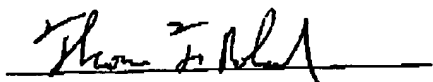
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Instead the Gitlitz reference only exemplifies non-triarylsilyl(meth)acrylates, at mol percentage levels of from 20-40 mol%, and full paint compositions that have erosion rates starting at 2 microns/month and above without an upper limit. All of the disclosure and Examples in fact teach away from Applicant's amended claims in several ways. There is no motivation to select only Applicant's claimed low mol% levels, of only arylsilyl(meth)acrylate terpolymers. One in the art would not even arrive at these from routine experimentation, since Applicant is claiming an erosion rate of the copolymer – which is not recognized as a result-effective variable by the Gitlitz reference, and therefore cannot be optimized.

There is no teaching or suggestion in the Gitlitz reference to motivate one in the art to use a mole% of a triarylsilyl (meth)acrylate below 20% to achieve an erosion rate of the terpolymer of 2 to 15 microns /month.

In view of the above, the Applicant believes that the reasons for rejection have been overcome, and the claims, as amended herein, should be allowable to the Applicant. Accordingly, reconsideration and allowance are requested.

Respectfully submitted,



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